

Application No: 10/780,473  
Attorney's Docket No: PHN16-613A

### **REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. Claims 11-14 have been amended. Currently, claims 11-16 are pending in the present application of which claims 11, 15, and 16 are independent. No new matter has been added.

Claims 11 and 13-16 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Lancelot (U.S. Patent Number 6,026,086). Claims 12 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lancelot in view of Deiss (U.S. Patent Number 5,802,063) (Claim 12 was listed as being rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Lancelot as well; however, in view of the examiner's failure to discuss any rejection of claim 12 under 35 U.S.C. § 102(e), this is believed to be an error.).

#### **Claim Rejection Under 35 U.S.C. §102**

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

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Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 11 and 13-16 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the disclosure contained in Lancelot. This rejection is respectfully traversed because the claimed invention as set forth in claim 11 and the claims that depend therefrom is patentably distinguishable over Lancelot.

Lancelot discloses a circuit switched network interface for communication of a circuit switched network protocol signal; a packet-based network interface for communication of a packet-based network protocol signal; and a transceiver for the transmission and reception of a first protocol signal. A communications controller is coupled to the circuit switched network interface, the packet-based network interface and the transceiver. The communications controller, through a set of program instructions and an interworking function, interconverts the first protocol signal with the circuit switched network protocol signal and interconverts the first protocol signal with the packet-based network protocol signal. Lancelot's network has a primary node for translating data into a form suitable for transmission over a packet-based network, or over a circuit-based network. Lancelot's network also has a secondary node which transmits data to the primary node using a defined protocol, such as CACS (See Abstract, Col. 3, lines 45-60).

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According to an embodiment of the invention, a communication network comprises a plurality of secondary nodes being coupled to at least one primary node. The secondary nodes transmit packets to the primary node; and include a first address translation means for translating initial address information carried by packets received from at least one terminal device into address information carrying information about the transmission properties to be used for transmitting the packets to the primary node.

Claim 11, as amended, recites a communication network including "secondary nodes comprising a transmitter for transmitting packets according to predetermined transmission properties; and a first address translator for translating initial address information carried by packets... into address information carrying information about... the predetermined transmission properties to be used for transmitting the associated packets." Lancelot fails to disclose the translation of address information into information about the transmission properties to be used for transmission, as recited in claim 1. Specifically, Lancelot fails to disclose the translation of initial address information carried by packets into information about the transmission properties to be used for transmitting the associated packets by a secondary node. Further, while Lancelot's primary nodes are able to transmit according to different transmission properties (i.e., packet-based vs. circuit-based; see Col. 3, lines 45-67), there is no teaching that the secondary node is able to transmit according to predetermined transmission properties included within initial address information of packets.

Accordingly, Lancelot fails to disclose all of the features contained in claim 11, and thus, this claims are believed to be allowable. Claims 13-14 depend upon allowable claim 11 and are

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also allowable at least by virtue of their dependencies. The Examiner is therefore respectfully requested to withdraw the rejection of claim 11, 13, and 14.

Claim 15 recites a "destination node for communication in a communication system having a plurality of source nodes arranged for transmitting of packets containing initial address information..., the destination node arranged to perform a second address translation, translating the address of the destination node back into the initial address information." Lancelot fails to disclose translating the address of the destination node back into the initial address information, as recited in claim 1. Lancelot provides reverse address resolution protocol (RARP) functionality, for the primary station (destination node) to determine whether a packet from a first secondary station is destined for another, second secondary station. However, Reverse Address Resolution Protocol (RARP) is a protocol used to resolve an IP address from a given hardware address. The primary station also translates IP addresses into hardware addresses (Col. 11, lines 20-30) of secondary stations. Thus, the primary station merely translates IP addresses into hardware addresses, and vice versa. It is not clear that the destination node would therefore translate the address of the destination node back into the initial address information received from a source node.

Accordingly, Lancelot fails to disclose all of the features contained in claim 15, and thus, this claims are believed to be allowable. The Examiner is therefore respectfully requested to withdraw the rejection of claim 15.

Claim 16 recites a "communication method comprising... translating initial address information carried by packets received from at least one terminal device into address

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information carrying information about the transmission properties to be used for transmission of the packets." Lancelot fails to disclose the translation of address information from a terminal device into information about transmission properties, as recited in claim 1. Specifically, Lancelot fails to disclose the translation of initial address information carried by packets into information about the transmission properties to be used for transmitting the associated packets.

Accordingly, Lancelot fails to disclose all of the features contained in claim 16, and thus, this claims are believed to be allowable. The Examiner is therefore respectfully requested to withdraw the rejection of claim 16.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claim 12 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lancelot in view of Deiss. The Applicants submit that claim 11 is not anticipated by Lancelot. In addition, the Official Action does not rely upon Deiss to make up for the deficiencies in Lancelot with respect to claim 11. Therefore, claim 12 which depends from claim 11 is allowable at least by virtue of its dependency. The Examiner is therefore respectfully requested to withdraw the rejection of claim 12.

#### Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

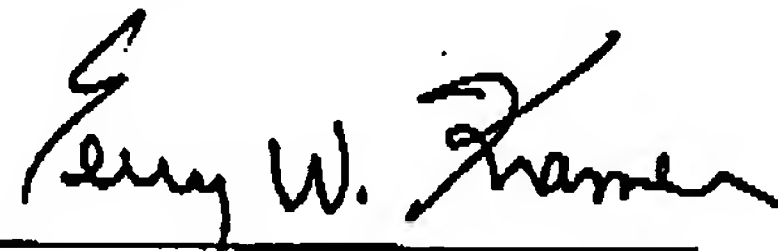
While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.



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Respectfully submitted,  
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